

## REMARKS

By this Amendment, claim 1 is amended and claims 4 and 8 are canceled to place this application in condition for allowance. Currently, claims 1-3, 5-7, 9, 10, and 12 are before the Examiner for consideration on their merits, with claim 11 presumably withdrawn from consideration.

In review, the Examiner indicated that claim 12 was directed to an invention different from that being prosecuted, and held that it is withdrawn from consideration. However, it seems that the Examiner meant claim 11 rather than claim 12 since claim 11 is a method claim, whereas claim 12 is a joint claim. Clarification is requested that it is claim 11 that is withdrawn from consideration.

It is also argued that since claim 1 requires the particulars of claim 1, that the restriction requirement should be withdrawn if claim 1 is found to be allowable. In the alternative, if the Examiner continues to contend that claim 11 is drawn to a different invention in spite of the allowability of claim 1, the Examiner is authorized to cancel said claim.

In the Office Action, the Examiner maintains the rejection of claims 1-4, 6-8, and 10 based on United States Patent No. 4,871,194 to Kawashima when taken in view of the Bestolife article (Bestolife). It is contended that the revision to claim 1 moots this rejection and claim 1 and its dependent claims are now in condition for allowance.

In review, claim 1 is now limited to an undercoating that is made from Cu, Ni, Sn, Cr, Co, and precious metals and alloys thereof. Notably, Zn and Al are now excluded from this list. By this Amendment it is contended that the rejection based on Kawashima and Bestolife is no longer valid and must be withdrawn. That is, even if Bestolife were combined with Kawashima, Kawashima still fails to teach the undercoating as now claimed since Kawashima does not teach the claimed undercoating. Moreover, it is contended that there is no reason to arrive at the invention

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based on the teachings of Kawashima since modifying Kawashima and alleging that the claimed undercoating would be obvious would be the application of hindsight.

Applicants also wish to incorporate by reference the arguments set forth in the filings of June 2 and 17, 2005. That is, Applicants still contend that at the very least, the discovery of the invention in terms of improved galling resistance at high temperatures is an unexpected result that rebuts any contention of obvious set forth by the teachings of Kawashima and Bestolife. Put another way, Applicants have discovered that the use of the claimed undercoating layer and claimed lubricant produces unexpected improvements in terms of high temperature galling resistance, and these results rebut any obviousness contention.

Applicants also wish to challenge some of the assertions made in the final rejection.

First, the Examiner contends that Kawashima teaches a thickness of the lubricating layer in cols. 3 and 4. This assertion is challenged since Applicants are unable to find any reference to a thickness of a lubricating layer in Kawashima. As previously argued, the thickness of the applied layer is important in obtaining the desired properties, see especially the arguments relating to claim 12. Moreover, Kawashima teaches that the lubricant is firmly retained in the porous layer, see col. 4, lines 46 and 47. The Examiner is respectfully requested to substantiate this position that Kawashima teaches a specific thickness of the lubricating layer in the next Office Action.

Second, the Examiner has also failed to address the arguments regarding claim 6 and the presence of a solid lubricant and organic or inorganic binder. In the last Amendment, it was argued that the Examiner did not provide a basis to reject claim 6. In response to this position, the Examiner states that the Kawashima lubricant meets the claim limitations. The problem with this position is that the Examiner has replaced the Kawashima lubricant with the Bestolife lubricant, so that the Kawashima lubricant is no longer present. Again, the Examiner is requested to provide a

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factual basis to reject claim 6 or indicate that it is allowable.

Third, the Examiner apparently is using Applicants' arguments as set forth on page 8 of the June 2, 2005 Amendment as an admission that Kawashima teaches a lubricating layer that meets the claimed limitations. No such admission was made on page 8. In fact, the gist of the argument on page 8 of the Amendment is that the lubricating material of Kawashima impregnates the porous undercoating layer, and that there is **no** thickness to speak of. The Examiner cites col. 4, lines 40-45 to support the allegation that grease is placed "on" the undercoating layer, but a close reading of this passage makes it clear that the grease is impregnated into the undercoating; it is not placed "on" the coating as alleged in the Office Action.

Fourth, the Examiner fails to address the argument that the reliance on Brooks is misplaced. In the final rejection, it was argued that one would be motivated to use the Brooks lubricant in place of the lubricant of Kawashima. However, the Examiner also took the position that it would be obvious to use the lubricant of Bestolife for the lubricant of Kawashima. These two positions are at odds with each other, and the rejection of claims 5 and 9 is improper for this reason alone. Moreover, it was argued that the use of the Brooks lubricant conflicts with the use of the proprietary Bestolife lubricant given their disparity, and this conflict taints the rejection so as to mandate its withdrawal.

Lastly, the Examiner finds unpersuasive the argument that the undercoating strengthens the bonding of the lubricating layer placed on the undercoating. To support this position, the Examiner refers to the fact that the claimed undercoating has a porosity of 5-80% which is the same as that found in Kawashima. The problem with this position is that it fails to take into account a distinguishing feature of the invention, i.e., the lubricant placed on the undercoating. The porosity of the undercoating of Kawashima does not end the inquiry since, as pointed out above, there is no

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thickness of lubricant placed on the undercoating for the undercoating to have a positive effect on the bond of the lubricant to the undercoating.

In light of the arguments made in the June 2 and 17, 2005 responses and those made herein, it is respectfully contended that the Examiner has failed to either establish a *prima facie* case of obviousness against claim 1, or any such case of obviousness is rebutted by the unexpected results associated with the invention. Moreover, it is still contended that claims 5, 6, 9, 10, and 12 are also separately patentable over the prior art for the reasons set forth above and those previously presented.

Accordingly, the Examiner is respectfully requested to examine this application in light of this amendment and pass claims 1-3, 5-7, and 9-12 onto issue.

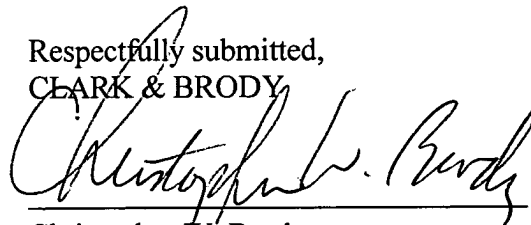
If an interview would expedite allowance of this application, the Examiner is invited to telephone the undersigned at 202-835-1753.

The above constitutes a complete response to the Office Action of August 31, 2005. A one-month extension of time is respectfully requested. A check in the amount of \$910.00 is attached for the extension of time fee (\$120.00) and the RCE fee (\$790.00), however, please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Again, reconsideration and allowance of this application is respectfully solicited.

Respectfully submitted,  
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By



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